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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,792	08/04/2003	Yuki Amano	241168US0	5557

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EXAMINER	
PENG, KUO LIANG	
ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 12/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/632,792	**Applicant(s)** AMANO ET AL.
	Examiner Kuo-Liang Peng	**Art Unit** 1712

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 November 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See the notes in next page.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *4-6,8 and 9*.
   Claim(s) withdrawn from consideration: *11 and 12*.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

Kuo-Liang Peng
Primary Examiner
Art Unit: 1712

1. Applicants should notice that Claims 11-12 had been withdrawn from consideration. In the next response, Applicants are advised to properly reflect their status in the claim status identifiers.

2. Claim rejection(s) under 35 USC 102 as being unpatentable over JP406 (JP 10-316406) in the previous Office Action (Paper No. 070806) is/are removed. Applicants' argument is persuasive.

3. Claim rejection(s) under 35 USC 102(b) and 103(a) based on Shibasaki (US 5 483 525) in the previous Office Action (Paper No. 070806) is/are removed. Applicants' argument is persuasive. It is noted that the octyltrimethoxysilane recited in Example 2 has a C8 alkyl group, not C18 alkyl group.

4. Claim rejection(s) under 35 USC 102(b) based on Kobayashi (US 4 849 022) in the previous Office Action (Paper No. 070806) is/are removed. Kobayashi does not teach or fairly suggest a long chain alkylsilane set forth in the claimed invention.

5. Rejection of Claims 4, 6 and 8-9 under 35 USC 112 is maintained because the rejection is adequately set forth in paragraph 4 of Paper No. 070806. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 9, 2nd and 3rd paragraphs), Examiner disagrees. Applicants' specification ([0004]) refers to several possible volatile organic components such as residual surface modifying agents, low molecular weight oligomers in silicone oil. However, this is not a definition. Furthermore, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. In re Van Guens, 988 F. 2d 1811, 26 USPQ 2d 1057 (Fed. Cir. 1993) Since the amount of the volatile organic components is very critical in determining the patentability for the claimed invention, a clear definition of the volatile organic compounds is necessary. Otherwise, the amount thereof is meaningless. As mentioned in Paper No. 102905 (paragraph 4), "volatile" is a relative term. This issue is closely related to the questions: a) what volatility is considered as volatile and b) how the amount of residual volatile organic components is determined (i.e., under what conditions, e.g., temperature, duration of heating, any gas flushing, rate of flushing, types of flushing gas (e.g., oxidizing or inert gas), etc.) Note that in Applicants' examples, only the heating treatment processes are described. The method for determining the amount of the residual volatile components are not even mentioned. Applicants would appreciate that for the same surface-treated inorganic oxide powder, if the amount of the residual volatile components is determined under a relatively higher temperature, longer duration of heating, in the presence of oxidizing flushing gas, higher flushing rate, etc., the determined amount will certainly be greater than that obtained under a relatively lower temperature, shorter duration of heating, in the absence of a flushing gas or in the presence of an inert flushing gas, lower flushing rate, etc.

5. Rejection of Claims 4 and 6 under 35 USC 103(a) as unpatentable over JP976 (JP 63-043976) in view of Kabayashi (US 4 849 022) is maintained because the rejection is adequately set forth in paragraph 8 of Paper No. 012905. Amended Claims 8-9 are rejected, too. For Claims 8-9, the inorganic oxide can be silica, alumina, etc. (page 3, upper left column).

For Applicants' argument (page 8, last paragraph), Applicants argue that JP976 does not teach a second heating step. However, as mentioned in the previous Office actions, However, the instant claims are product-by-process claims. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process" In re Thorpe, 777 F. 2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Furthermore, the claimed invention does not necessarily needs a two-step heat treatment because when the temperatures of the two heat treatments are the same (i.e., from 200oC up to 150oC), the second step is merely the extension of the first one. Regarding the alleged unexpected results in view of Applicants' Example 5 and Comparative Example 5, Examiner disagrees because the heat treatment temperatures are different. Therefore, the product of JP976 in view of Kabayashi would meet the residual volatile organic components limitation of the present claims.